

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 03-284-E)

In the Application of:)	
)	
Costa et al.)	Before the Examiner:
)	Halvorson, M.
Serial No. 10/809,144)	
)	Group Art Unit: 1642
Filing Date: March 25, 2004)	
)	
For: Methods of Inhibiting Tumor)	Confirmation No.: 7397
Cell Proliferation)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REQUEST PURSUANT TO MPEP § 710.06, REQUESTING THE ISSUANCE OF
A NEW OFFICE ACTION AND RESETTING OF THE REPLY PERIOD**

Dear Sir:

Pursuant to MPEP §710.06, Applicants respectfully request that the Patent Office issue a new office action and reset the reply period because 1) the office action contains an error in the citation of a reference, which affects Applicant's ability to reply to the Office action, and 2) the Applicants are submitting this request within one month of the mailing date of the Office Action.

A Final Office action was mailed on January 8, 2009, in which claims 50, 54-65 are allowed, claim 72 is objected to, and claims 66-71 are rejected under 35 U.S.C. 102(b) over Sherr et al. (U.S. Patent No. 5,723,313) ("the '313 patent").

The Action asserted that the '313 patent claims a method of preventing abnormal cell growth in a mammalian cell comprising administering a composition comprising a pharmaceutically acceptable carrier and an effective amount of a peptide, wherein the peptide consists of 10 to 50 amino acid residues comprising the amino acid sequences of SEQ ID NO:47 and SEQ ID NO:48. The Action further asserted that the genus of p19ARF

fragments encompassed by claim 17 of the '313 patent would overlap with the genus of p19ARF fragments of claims 66-71.

Applicants respectfully point out that the Action's assertion is incorrect. The '313 patent does not teach "SEQ ID NO:47" or "SEQ ID NO:48," nor does the '313 patent contain a claim 17. The '313 patent discloses 12 sequences: from SEQ ID NO:1 to SEQ ID NO:12. Further, the '313 patent contains only four claims. Thus, the citation of the reference in the Final Action dated January 8, 2009 is incorrect.

CONCLUSION

The Applicants respectfully submit that the above identified errors in the Office action are being brought to the Office's attention within one month of the mailing date of the Office Action and that these errors affect Applicants' ability to reply to the Office action. Consequently, Applicants respectfully request the issuance of a new Office action and restarting the previously set period for reply to run from the date the error is corrected in the new Office action.

It is believed that no fee is due in connection with this filing; however, if a fee is due, the Commissioner is authorized to charge Deposit Account No. 13-2490 in the amount due. Should the Examiner believe a discussion of this matter would be helpful, he is invited to telephone the undersigned at (312) 913-0001.

Respectfully submitted,

Dated: February 6, 2009

By: /Y. Elaine Chang/
Yijian Elaine Chang
Reg. No. 54,698

McDonnell Boehnen Hulbert & Berghoff LLP

300 South Wacker Drive, Ste 3100
Chicago, IL 60606
Telephone: (312) 913-0001
Facsimile: (312) 913-0002